



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/803,349

03/18/2004

Jacqueline Erlebacher

29617/SH009A

5816

4743

7590

08/03/2006

MARSHALL, GERSTEIN & BORUN LLP  
233 S. WACKER DRIVE, SUITE 6300  
SEARS TOWER  
CHICAGO, IL 60606

EXAMINER

WALCZAK, DAVID J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                   |  |
|------------------------------|------------------|-------------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)      |  |
|                              | 10/803,349       | ERLEBACHER ET AL. |  |
|                              | Examiner         | Art Unit          |  |
|                              | David J. Walczak | 3751              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 3-6, 8, 13, 17, 19, 22, 23, 25-38, 40-43, 47, 48, 55 and 57-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, 44-46, 49-54, 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/04, 1/05 &amp; 4/06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election of Species and Sub-species***

The Applicant initially requests that the dispenser shown in Figure 13 be classified as a separate sub-species. After further consideration, the Examiner will separately classify the dispenser shown in Figure 13 as Sub-species M.

Applicant's election with traverse of Species V, Sub-species M in the reply filed on 6/6/06 is acknowledged. The Applicant requests that Species V, VI and IX be rejoined. The traversal is on the ground that there is not serious burden to examine these three species. This is not found persuasive because, firstly, the Applicant has not indicated on the record that these embodiments are obvious variants of each other. Secondly, as evidenced by the Applicant, claims 17 and 57-63 would also have to be examined should these species be rejoined. Since different claims are directed to different species, and the examination of one embodiment and a set of claims is clearly less burdensome than the examination of three embodiments and a greater amount of claims, Species V, VI and IX will not be rejoined. Further, as the Applicant has not indicated on the record that Species V, VI and IX are obvious variants of each other, the species will not be rejoined.

The Applicant has indicated that claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39, 44-46, 49-54 and 56 read on the elected embodiment (Species V, Sub-species M) and, accordingly, these claims will be examined herein. The remaining claims are withdrawn from further consideration at this time.

The requirement is still deemed proper and is therefore made FINAL.

### ***Abstract***

The abstract of the disclosure is objected to because phrases that can be implied, such as "Disclosed herein" should not be present therein. Correction is required. See MPEP § 608.01(b).

### ***Specification***

The disclosure is objected to because of the following informalities: The disclosure is replete with minor informalities, i.e., on page 12, line 26, "body 950" should be --body 951--, on page 12, line 28, "920" should be --901--, on page 13, lines 6 and 7, "950" should be --901-- and on page 13, line 8, "cap 960" should be --highlighter 950--. The Applicant should review the entire specification and correct any and all other errors that may be present therein. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The terms "dispenser housing" (claim 1), "barrel portion" claim 7 and "insertion cylinder" (claims 24 and 39), do not have antecedent basis in the specification with regard to the elected embodiment. It appears that the term "dispenser housing" is intended to defined cap 973 and the "barrel portion"/"insertion cylinder" is intended to define nub 902 and the claims will be examined as such.

### ***Claim Objections***

Art Unit: 3751

Claim 16 is objected to because of the following informalities: On line 1 of claim 16, it appears that "dispenser base" should be "dispenser housing" since it is the housing/cap 973 that includes the recess 903 to be fit over a writing tip (see paragraph 0058). The specification does not disclose (with regard to the elected embodiment) a recess in the base of the dispenser for receiving a writing tip. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 46 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to these claims, it is unclear as to whether or not the writing instrument is intended to be part of the claimed combination. For example, the language in claim 45 (from which these claims depend) indicates that the writing instrument is not intended to be claimed. The language in claims 46 and 56, however, seem to indicate that the writing instrument is intended to be part of the claimed combination. Should the Applicant intend to claim the writing instrument, an antecedent basis for the instrument should be defined. Should the Applicant not intend to claim the instrument, --adapted to be-- language should be used when referring thereto.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 9, 10, 14, 16, 18, 20, 45 and 49-52 are rejected under 35

U.S.C. 102(b) as being anticipated by Ross. In regard to claim 1, Ross discloses a writing instrument with a sheet material dispenser comprised of a writing instrument body portion 30 having a writing tip, a dispenser base 11, 12 adapted for attachment to the writing instrument body, a dispenser housing 24 coupled to the dispenser base wherein the housing 24 has an opening 26 which communicates with an interior receptacle and a roll of sheet material R disposed in the interior receptacle wherein a leading edge of the sheet material passes through the opening 26. In regard to claim 2, the interior receptacle has a generally cylindrical shape. In regard to claim 9, the base comprises an inner shell 11 sized for insertion into the housing 24 and an inner surface sized to receive the roll of sheet material wherein the inner shell includes an end cover 16 attached to one end of the inner shell and wherein the inner shell has opposing first and second ends which define a slot 14 therebetween sized to receive the sheet material. In regard to claim 10, the housing opening 26 is formed as an outer slot in register with the inner slot (see Figure 2). In regard to claim 14, the base is removably attached to the writing instrument. In regard to claim 16, the base 11 has a recess sized to releasably engage the writing instrument (as shown in Figure 1) and sized to enclose the writing tip (i.e, the base is capable of receiving the writing tip end of the

writing instrument). In regard to claim 18, as discussed above, the base is removably attached to the writing instrument. In regard to claim 20, as discussed supra, the base includes a cylindrical shell 11 having a slot 14 and an inner chamber sized to receive the roll of sheet material. In regard to claims 45 and 49-52, as discussed above, the Ross device discloses the claimed structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11, 12, 21, 44, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross. Although the Ross reference does not disclose the specifically claimed structure of the roll of sheet material, the Examiner takes official notice that the claimed types of sheet material are commonly dispensed from housings in order to enable a user to effectively dispense sheets when needed. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any suitable type of known sheet material, including those claimed, can be dispensed from the Ross device without effecting the overall operation thereof.

Claims 7, 15, 24, 39, 46 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Connors. Although the base portion of the Ross

device is structure to be slid over a writing instrument and does not include a nub which is received in the end of a writing instrument, as claimed, attention is directed to the Connors reference, which discloses another writing instrument having a paper dispenser wherein the dispenser base 12 includes a nub 16 that is inserted into an opening at the end of the writing instrument in order to enable the housing to be securely attached thereto. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made do design the base and writing instrument in the Ross device as such wherein such a modification amounts to the mere substitution of one functionally equivalent connecting mechanism for another and the selection of either connecting mechanism would work equally well on the Ross device.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
7/26/06